

R E M A R K S**I. Introduction**

Claims 1-37 are pending in the application. All pending claims stand rejected. In particular, (1) claims 1-4, 9, 12, 18-19, 22, 24-25, 31, and 36-37 stand rejected under 35 U.S.C. §103 as being unpatentable over U.S. Patent No. 6,266,682 (hereinafter "LaMarca"), in view of U.S. Patent No. 5,737,739 (hereinafter "Shirley"), (2) claims 5-8, 10, and 13-14 stand rejected under 35 U.S.C. §103(a) as being unpatentable over LaMarca in view of Shirley, in further view of U.S. Patent No. 6,510,434, (3) claims 11, 15, 17, 20-21, 23, 26-27, 29-30, and 32-35 stand rejected under 35 U.S.C. §103(a) as being unpatentable over LaMarca in view of Shirley, in further view of U.S. Patent No. 6,598,046 (hereinafter "Goldberg"), (4) claim 28 stands rejected under 35 U.S.C. §103(a) as being unpatentable over LaMarca in view of Shirley, in further view of Goldberg, and in further view of Anderson, and (5) claim 16 stands rejected under 35 U.S.C. §103(a) as being unpatentable over LaMarca in view of Shirley, in further view of Goldberg, and in further view of U.S. Patent No. 6,055,543.

Upon entry of this amendment, which is respectfully requested, claims 1-25 and 27-36 will be cancelled without prejudice or disclaimer, claims 26 and 37 will be amended to more distinctly claim current embodiments, and claims 38-52 will be added. No new matter is believed added by this amendment. Support for all amendments exists in the specification and claims as originally filed.

Applicants respectfully request reconsideration and further examination of the pending claims in view of the arguments presented herein.

II. The Examiner's Rejections

Amended claim 26 stands rejected under 35 U.S.C. §103(a) as being unpatentable over LaMarca in view of Shirley, in further view of Goldberg. Amended claim 37 stands rejected under 35 U.S.C. §103(a) as being unpatentable over LaMarca in view of Shirley. Applicants respectfully traverse these grounds for rejection as follows.

1. The references fails to teach or suggest, either alone or in combination, *a first document tag that is associated with a first domain having a single-rooted, hierarchical data structure and a second document tag that is associated with a second domain having a single-rooted, hierarchical data structure*

Applicants respectfully assert that neither LaMarca, Shirley, nor Goldberg, teach, suggest, or render obvious embodiments as described in amended claims 26 and 37. For example, none of the cited references teach or suggest *a first document tag that is associated with a **first domain** having a single-rooted, hierarchical data structure **and** a second document tag that is associated with a **second domain** having a single-rooted, hierarchical data structure* (a limitation generally included in each of the above-referenced amended claims).

LaMarca does not describe the use of multiple tags for a document, much less first and second tags being associated with first and second domains. Instead, LaMarca describes inserting a tag into the path of a document "to identify the document and represent a dynamic collection" and using "[t]he same tag" by inserting it "into the path of files which support the document so that the supporting files are related to the document". (Abstract). While documents themselves may be stored in a hierarchical file system in LaMarca, those documents are not associated with first and second tags associated with first and second domains.

Shirley does describe assigning multiple tags to a document (Col. 3). The tags utilized in Shirley however, are not related to first and second domains having single-rooted, hierarchical data structures. For example, Shirley describes a system having multiple flowcharts, each flowchart or "decision tree" being represented by a single document called a "repair analysis document" or "RAP". (Col. 5, lines 14-27). Each RAP document may be assigned multiple tags (*e.g.*, query tags, corrective action tags, and cross-reference tags). Nowhere does Shirley describe assigning multiple tags to a document where the tags are associated with different domains.

Goldberg generally describes looking up or retrieving documents based on "a user's role, scenario, and context in a given context or scenario." (Abstract). Nowhere does Goldberg describe assigning first and second tags to a document where the tags are associated with first and second domains having single-rooted, hierarchical data structures.

Applicants therefore respectfully assert that combinations of the cited references fail to disclose or suggest embodiments as recited in amended claims 26 and 37, at least because the references do not disclose or suggest *a first document tag that is associated with a first domain having a single-rooted, hierarchical data structure and a second document tag that is associated with a second domain having a single-rooted, hierarchical data structure.*

Moreover, the teaching or suggestion to make the claimed combination must be found in the prior art, and not based on the Applicants' disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). The fact that references can potentially be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. MPEP 2143.01; In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990); Monarch Knitting Machinery Corp. v. Sulzer Morat GmbH, 45 USPQ 2d 1977, 1981-82 (Fed. Cir. 1998) (the question to be asked is "whether the prior art contains a suggestion or motivation to combine references").

According to the Office Action, it would have been obvious to combine LaMarca and Shirley since it "would be advantageous because by relating documents based on content with multiple unique tags, a document management system[] can then easily identify and retrieve more related documents relevant to a user [which] otherwise would possible not be identified and retrieve[d] based on just one tag" (page 3). The mere fact that the present invention is advantageous does not render these claims obvious.

"That an inventor has probed the strengths and weaknesses of the prior art and discovered an improvement that escaped those who came before is indicative of unobviousness, not obviousness." Fromson v. Anitec Printing Plates, Inc., 45 USPQ 2d 1269, 1276 (Fed. Cir. 1997), cert. denied, 119 S. Ct. 56 (1998). By providing document tags in different domains having single-rooted, hierarchical data structures, Applicants have addressed several problems of the prior art (e.g., by improving the ability to locate financial investment documents of interest).

“[T]he suggestion to combine requirement is a safeguard against the use of hindsight combinations to negate patentability.” In re Rouffet, 47 USPQ2d 1453 (Fed. Cir. 1998). The absence of any motivation in the prior art references to _ indicates that the Examiner has simply recognized a benefit provided by the present invention, and then used that benefit as a motivation to combine the references – the essence of impermissible hindsight reconstruction.

Because there is no teaching or suggestion to modify the references in this way, a *prima facie* case of obviousness has not been established and the rejection of claims 26 and 37 should be withdrawn.

2. The references fails to teach or suggest, either alone or in combination, automatically assigning a second document tag to the document based on a rule associated with the first document tag

Applicants respectfully assert that neither LaMarca, Shirley, nor Goldberg, teach, suggest, or render obvious embodiments as described in amended claims 26 and 37. For example, none of the cited references teach or suggest *automatically assigning a second document tag to the document based on a rule associated with the first document tag* (a limitation generally included in each of the above-referenced amended claims).

LaMarca does not describe the use of multiple tags for a document, much less automatically assigning a second document tag based on a rule. Instead, as described above, LaMarca describes associating support files for a document by placing a tag in the path of the document and the corresponding support files. (Abstract). In other words, the document and support files in LaMarca share the same, single tag.

As described above, Shirley does describe assigning multiple tags to a document (Col. 3). The tags utilized in Shirley however, are not automatically assigned based on rules, nor is a second tag in Shirley automatically assigned to a document based on a rule associated with a first tag associated with the document. For example, the tags in Shirley are described as being assigned to documents by the author of the document (*e.g.*, the service manual author) in order to manifest the understanding the author has for the subject matter into the document. (Col. 4, lines 38-47). Nowhere in Shirley are tags "automatically" assigned to a document. Nor are tags

assigned to a document based on rules or based on rules associated with other assigned tags. Shirley is simply not directed to, and simply does not describe such embodiments.

Goldberg, as described above, is generally directed to retrieving and ranking documents based on a user's scenario or criteria. Goldberg does not describe the automatic assignment of document tags much less the automatic assignment of a second tag based on a rule associated with a first assigned tag.

Applicants therefore respectfully assert that combinations of the cited references fail to teach, suggest, or render obvious, embodiments as recited in amended claims 26 and 37, at least because the references fail to teach or suggest *automatically assigning a second document tag to the document based on a rule associated with the first document tag*.

Further, Applicants respectfully assert that there is simply no motivation in any of the references to modify any other reference to provide the claimed feature of *automatically assigning a second document tag to the document based on a rule associated with the first document tag*. Once again, by automatically assigning a tag based on a rule, Applicants have addressed several problems of the prior art (e.g., by classifying financial investment documents more efficiently). There is no suggestion in the prior art that the references should be combined in such a way, nor would such a combination have been obvious.

Applicants therefore respectfully request that the §103 rejections of amended claims 26 and 37 be withdrawn.

3. The references fails to teach or suggest, either alone or in combination, receiving an indication from the content publisher, the indication at least regarding the automatically determined associated tag

Applicants respectfully assert that neither LaMarca, Shirley, nor Goldberg, teach, suggest, or render obvious embodiments as described in amended claim 26. For example, none of the cited references teach or suggest *receiving an indication from the content publisher, the indication at least regarding the automatically determined associated tag* (a limitation included in claim 26).

As described above, LaMarca is not directed to automatically assigning tags to documents. More particularly, LaMarca does not describe receiving an indication from a content publisher regarding an automatically selected tag. For example, LaMarca does not automatically

assign a tag to a document and then receive an approval for such an assignment from the document's author (which is one form of indication that may be received, for example, in currently claimed embodiments).

Similarly, as described above, Shirley does not automatically assign tags to a document. Nor does Shirley describe receiving an indication regarding an automatically associated tag from a content publisher. In other words, Shirley does not automatically assign a tag to a document and then receive feedback from the document's author regarding the appropriateness of the automatically selected tag (which would be one form of indication that may be received, for example, in currently claimed embodiments).

As described above, Goldberg does not automatically assign tags to a document. Nor does Goldberg receive any indication from a content publisher, much less an indication regarding an automatically selected tag. Goldberg describes maintaining a repository of documents that may be searched through by users, but Goldberg does not describe any indications or other communications being received from authors of those documents.

Applicants therefore respectfully assert that combinations of the cited references fail to teach, suggest, or render obvious, embodiments as recited in amended claim 26, at least because the references fail to teach or suggest *receiving an indication from the content publisher, the indication at least regarding the automatically determined associated tag*.

Further, Applicants respectfully assert that there is simply no motivation in any of the references to modify any other reference to provide the claimed feature of *receiving an indication from the content publisher, the indication at least regarding the automatically determined associated tag*. By assigning a second document tag based on an indication received from a content publisher, Applicants have addressed several problems of the prior art (*e.g.*, by improving the efficiency and accuracy of financial investment document classification). There is no suggestion in the prior art that the references should be combined in such a way, nor would such a combination have been obvious.

Applicants therefore respectfully request that the §103 rejection of amended claim 26 be withdrawn.

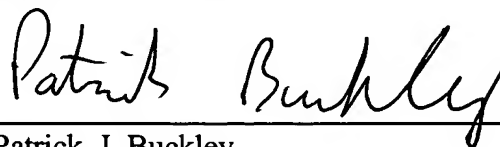
4. Newly added claims

New added claims 38-52 are believed patentable at least because they depend upon a patentable base claim (*e.g.*, for the reasons described above) or contain limitations similar to those described above with respect to claim 26.

III. Conclusion

Accordingly, Applicants respectfully assert that each of the claims is patentable over the cited references. Applicants therefore respectfully request that the Examiner's rejection of the pending claims be withdrawn and that all pending claims be allowed. Applicants' silence with respect to other comments made in the Office Action does not imply agreement with those comments. If any issues remain, or if the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is kindly invited to contact the undersigned via telephone at 203-972-0191.

Respectfully submitted,



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Date

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